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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,800	01/30/2002	Svetlana V. Shchegrova	10010464-1	1874

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AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
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EXAMINER

TRAN, MY CHAU T

ART UNIT PAPER NUMBER

1639

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/061,800	SHCHEGROVA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MY-CHAU T TRAN	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/2/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a method of fabricating a chemical array with the step of moving a second dispenser, classified in class 422, subclass 63.
  - II. Claims 6-24, drawn to a method of fabricating a chemical array with the step of detecting an error dispenser within a frame, classified in class 422, subclass 65.
  - III. Claims 25-33, drawn to a method of fabricating a chemical array with the step of detecting an error dispenser within multiple series of frame, classified in class 422, subclass 105.
  - IV. Claims 34-36, drawn to an apparatus with a processor that moves a second dispenser, classified in class 422, subclass 116.
  - V. Claims 37-40, drawn to an apparatus with multiple groups of dispensers that extends sideways, classified in class 435, subclass 286.2.
  - VI. Claims 41-43, drawn to a computer program product with a program that moves a second dispenser, classified in class 712, subclass 204.
  - VII. Claim 44, drawn to a computer program product with a program that detects an error dispenser, classified in class 719, subclass 318.
  - VIII. Claim 45, drawn to a method of reading an array, classified in class 435, subclass 4.
  - IX. Claims 46-47, drawn to method of forwarding data, classified in class 719, subclass 319.

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X. Claim 48, drawn to a method of receiving data, classified in class 710, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I, Group II, Group III, Group VIII, Group IX, and Group X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different method steps that have different functions and modes of operation.

The method step of moving a second dispenser of Group I is not required by the claims of Groups II, III, and Groups VIII, IX, and X. The method step of detecting an error dispenser within a frame of Group II is not required by the claims of Groups I, III, and Groups VIII, IX, and X. The method step of detecting an error dispenser within multiple series of frame of Group III is not required by the claims of Groups I, II, and Groups VIII, IX, and X. The method step of reading an array of Group VIII is not required by the claims of Groups I, II, III, and Groups IX, and X. The method step of forwarding data of Group IX is not required by the claims of Groups I, II, III, and Groups VIII, and IX. The method step of receiving data of Group X is not required by the claims of Groups I, II, III, and Groups VIII, and IX.

3. Inventions of Group IV, Group V, Group VI, and Group VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04,

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MPEP § 808.01). In the instant case the different inventions as claimed have different required components that have different functions and effects.

The feature of a processor that moves a second dispenser of Group IV is not required by the claims of Groups V, VI, and VII. The feature of multiple groups of dispensers that extends sideways of Group V is not required by the claims of Groups IV, VI, and VII. The feature of a computer program that moves a second dispenser of Group VI is not required by the claims of Groups IV, V, and VII. The feature of a computer program that detects an error dispenser of Group VII is not required by the claims of Groups IV, V, and VI.

4. Inventions of Group I (process) and Group IV (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of synthesizing proteins or a method of injecting samples into an HPLC. This restriction requirement is also applicable with the apparatus of Group V, Group VI, and Group VII.

5. Inventions of Group II (process) and Group IV (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of collecting samples from a GC. This restriction requirement is also applicable with the apparatus of Group V, Group VI, and Group VII.

6. Inventions of Group III (process) and Group IV (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of dispensing reagents or beads. This restriction requirement is also applicable with the apparatus of Group V, Group VI, and Group VII.

7. Inventions of Group VIII (process) and Group IV (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process.

(MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of synthesizing a library of DNA. This restriction requirement is also applicable with the apparatus of Group V, Group VI, and Group VII.

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8. Inventions of Group IX (process) and Group IV (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of synthesizing proteins or a method of injecting samples into an HPLC. This restriction requirement is also applicable with the apparatus of Group V, Group VI, and Group VII.

9. Inventions of Group X (process) and Group IV (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of dispensing reagents or beads or a method of injecting samples into an HPLC. This restriction requirement is also applicable with the apparatus of Group V, Group VI, and Group VII.

10. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group III would involve a



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determination of the patentability of the combination of method steps comprising the step of dispensing drops and the step of detecting an error dispenser within multiple series of frame (independent of its use) while a patentability determination for Group VI would involve a consideration of the patentability of a computer program product. These considerations are very different in nature.

Even though some of the groups are classified in the same class and/or subclass, this has no effect on the non-patent literature search. Different groups would require completely different searches in non-patent databases, and there is no exception that the searches would be co-extensive.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810.



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The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
March 17, 2004

  
PADMASHRI PONNALURI  
PRIMARY EXAMINER